UNITED STATES PATENT AND TRADEMARK OFFICE

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Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 07-01)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☐ Responsive to communication(s) filed on _____ .

2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-9* is/are pending in the application.

     4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☒ Claim(s) *4,5,8 and 9* is/are allowed.

6) ☒ Claim(s) *1-3,6 and 7* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on *12/6/99* is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

     If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

     a) ☒ All b) ☐ Some * c) ☐ None of:

        1. ☒ Certified copies of the priority documents have been received.

        2. ☐ Certified copies of the priority documents have been received in Application No. _____ .

        3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage
        application from the International Bureau (PCT Rule 17.2(a)).

     * See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

     a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *6,7,8* .

4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: .

DETAILED ACTION

Priority

1.   Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers

have been placed of record in the file.

Claim Objections

2.   Claim 8 is objected to because of the following informalities: a limitation of "a" user, in

line 11 of page 10, should be "the" or "said" user because it is repeated from the limitation of "a

user" in line 4 of page 10. Since claim 9 depends on claim 8, claim 9 is also objected.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

3.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United
> States before the invention thereof by the applicant for patent, or on an international application by another who
> has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention
> thereof by the applicant for patent.

4.   Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Motegi (US Patent

No. 6,307,640 B1).

As to claim 1, Motegi teaches a printer (a printer 107 in fig. 1) comprising:

an input unit (i.e., a panel; col. 3, lines 12-14 and 66-67 to col. 4, line 1: the printer has an

operational panel on which the user inputs the job number or password by the keypad);

a controller (i.e., a printer controller which has a CPU for controlling the printer

apparatus " col. 3, lines 9-11") for reading print type information together with print data (at step

S3 in the last column of fig. 3 shows either the printer or the printer server communicates with

the host computer 113 for receiving the information from the host computer 113, and col. 3, lines

49-52 describes that the printer 107 "or the printer server" receives the registered job number and

password with the image data from the host computer 113. The image data would be considered

as the print data "col. 2, lines 58-59", and the registered-job-number information and the

password information would be considered as the print type information because of the

confidential type of the print data) sent through a communication interface (i.e., a video and

command data interface, col. 3, lines 6-7) and performing printing of a confidential print data file

selected to be printed and received when a code (i.e., the job number and password are inputted

by the user) that is the same as a secret code set in the received print type information (i.e., the

registered job number and password are received by the printer from the host computer at step S3

in fig. 3) is input through the input unit (col. 3, line 66 to col. 4, line 1 describes that when the

user inputs the job number and password on the keypad of any selected printer, then if the

inputted job number and password from the user are matched with the registered job number and

password from the host computer that is read by the printer "or the printer server" at step S5 in

fig. 4 and col. 4, lines 1-6, and finally the printer prints the image data from the document "col.

4, lines 6-8");

an engine controlled by the printer controller for printing an image corresponding to the

print data to paper (the printer is controlled by the printer controller in column 3, lines 9-10.

Thus, the printer, which would inherently has an engine, is controlled for printing the image data into the recording medium such as papers "col. 4, lines 6-8").

(It is noted that the same operations are performed by either a printer server or a printer. "col. 3, lines 43-44" and in the last column of figure 3, discloses that either the printer server or the printer which would have the same operations. In the case of the operations at the printer, the printer directly communicates with the host computer 113 without communicating with the printer server. The following explanations based on the operations of the printer:

at step S2 in fig. 3 and col. 3, lines 46-49: the host computer 113 receives the print data including the print request message with image data from the user computer 101 via the network computer 105, and then registers the job number and password with the image data. The user knows the assigned job number and password from the host computer with his print job "col. 3, lines 51-55".

at step S3 in fig. 3 and col. 3, lines 49-52: the printer 107 receives the registered job number and password with the image data or only the registered job number " col. 3, lines 55-57" from the host computer 113;

at step S4 in fig. 3 and col. 3, line 66 to col. 4, line 1: the user inputs the job number and password on the keypad of the printer;

at step S5 in fig. 4 and col. 4, lines 1-6: the inputted job number and password from the user are compared with the registered job number and password at the printer. If matching, col. 4, lines 6-8, then the printer prints the documents).

Claim Rejections - 35 USC § 103

5.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

6.   Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Motegi, as applied

above in view of claim 1, in combination with Uematsu (US Patent No. 5,562,351).

As to claim 2, Motegi discloses every feature discussed in claim 1. Motegi further teaches

the printer controller for controlling the printer apparatus (col. 3, lines 9-10) and the confidential

print data to be printed is received (in step S3 in fig. 3 and col. 3, lines 51-52 show the printer

receives the confidential print data including the image data and the information of the registered

job number and password)

However, Motegi does not teach the printer controller controls a sound output device to

sound an alarm when the confidential print data is received.

Uematsu, in the same field of endeavor, teaches a printer (11 in fig. 3) comprising a

sound output device (i.e., a buzzer 38 in fig. 3), which sounds as a warning or for notice (col. 5,

lines 1-2), is connected and controlled by a controller (i.e., CPU 32 in fig. 3, col. 4, lines 58-59).

It would have been obvious to one having ordinary skill in the art at the time the

invention was made to modify the printer of Motegi in order to have an alarm unit for sounding,

as taught by Uematsu, when the received print data is the confidential print data. The suggestion

for modifying the printer of Motegi can be reasoned by one of ordinary skill in the art as set forth

above by Uematsu because the modified printer of Motegi would be desirable when its printer

controller has a function for informing the user a message through the buzzer if the confidential

print data is received. Therefore, any of the walkup users would easily know the confidential

print jobs those are received by the shared printer in the network.

7.   Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Motegi, as applied

above in view of claim 1, in combination with Ban (US Patent No. 6,332,170 B1).

As to claim 3, Motegi discloses every feature discussed in claim 1. Motegi further teaches

the received print data to be printed is the confidential print data (in step S3 in fig. 3 and col. 3,

lines 51-52: the print data with the job number and password is received and registered at the

printer) and the printer controller for displaying the viewing information (col. 3, lines 9-14

describes that the printer controller which includes an operation panel control unit for controlling

an operational panel, on which the user may enter data and view displayed information).

However, Motegi does not teach the printer controller displays a message through a

display device when the received print data is the confidential document.

Ban, in the same field of endeavor, teaches the printer controller (i.e., a controller in fig.

2) displays a message through a display device (13 in fig. 2, col. 3, lines 35-40) when the print

data is received by the printer (col. 4, line 67 to col. 5, line 2; it is noted that when the printer

receives and registers two different types of print jobs including the ordinary job and the manual

feed job " col. 4, lines 54-61", the message of the manual feed job select screen Q1 "please see

figure 4" is displayed through a display device "col. 4, line 67 to col. 5, line 1").

It would have been obvious to one having ordinary skill in the art at the time the

invention was made to modify the printer controller of Motegi for displaying the message on the

display unit 20, as taught by Ban, when the received print data is the confidential print data. The

suggestion for modifying the printer controller of Motegi can be reasoned by one of ordinary

skill in the art as set forth above by Ban because the modified printer controller of Motegi would

be desirable and reliable by providing instructions to the display device for displaying a message

to inform the user when the confidential type of print job is received and registered at the printer.

Therefore, any of the users would keep track and obtain his/her confidential print jobs at the

shared printer in the network.

8.   Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of

Motegi and Taniguchi et al. (US Patent No. 5,999,707).

        As to claim 6, Motegi discloses a method for printing a confidential document in a

printer, comprising the steps of:

        (a) reading print type information and a print data file (at step S3 in the last column of

fig. 3 shows either the printer or the printer server communicates with the host computer 113 for

reading the information of the print job from the host computer 113; and col. 3, lines 49-52

describes that the printer 107 "or the printer server" receives and reading the registered job

number and password with the image data from the host computer 113. The image data would be

considered as the print data file "col. 2, lines 58-59", and the registered-job-number information

and the password information would be considered as the print type information because of the

confidential type of the print data) received through a communication interface (i.e., a video and

command data interface, col. 3, lines 6-7);

        (b) a user to input a secret code (i.e., the job number and password is inputted by the user

at the keypad of the printer "col. 3, line 66 to col. 4, line 1") when the print type information is

set to be confidential printing (the job number and password are assigned with the print data by

the host computer "113 in fig. 1", and this information is read by the printer "or the printer server

in step S3 of fig. 3 and col. 3, lines 48-52". The print job would be the confidential type of print

data because it includes the confidential information such as the job number and password.

When the user actually makes the print request to his confidential print job, the user inputs the

job number and password on the keypad of the printer); and

(c) printing an image corresponding to the print data to paper when the secret code input

by the user in the step (b) is the same as the secret code set in the print type information (col. 3,

line 66 to col. 4, line 1 describes that when the user inputs the job number and password on the

keypad of the printer, then if the inputted job number and password from the user are matched

with the registered job number and password from the host computer that is received by the

printer "or the printer server" at step S5 in fig. 4 and col. 4, lines 1-6, and finally the printer

prints the document "col. 4, lines 6-8").

(It is noted that the operations are performed by either a printer server or a printer "col. 3,

lines 43-44" and figure 3 shows, in the last column, either the printer server or the printer would

have the same operations. In the case of the operations at the printer, the printer directly

communicates with the host computer 113 without communicating with the printer server. The

following explanation based on the operations of the printer:

at step S2 in fig. 3 and col. 3, lines 46-49: the host computer receives the print data

including the print request message with image data from the user computer via the network

computer, and then registers the job number and password with the image data. The user knows

the assigned job number and password from the host computer with his print job "col. 3, lines

51-55";

at step S3 in fig. 3 and col. 3, lines 49-52: the printer 107 receives the registered job

number and password with the image data or only the registered job number " col. 3, lines 55-

57" from the host computer 113;

at step S4 in fig. 3 and col. 3, line 66 to col. 4, line 1: the user inputs the job number and

password on the keypad of any selected printer;

at step S5 in fig. 4 and col. 4, lines 1-6: the inputted job number and password from the

user are compared with the registered job number and password at the printer. If matching,

col. 4, lines 6-8, then the printer prints the documents).

However, Motegi does not explicitly teach his printer to have a step of requesting the user

to input the job number and password.

Taniguchi, in the same field of endeavor, teaches that a printer has a step of requesting

(i.e., prompting) the user to input the password by displaying a message on its display means

(col. 7, lines 20-23 and col. 11, lines 38-41);

(it is noted that: 1) col. 7, lines 16-23 describes that the display unit "20 in fig. 4" of the

printer "P1 or P2 in fig. 4" requests the user to input the password when the user selects a desired

print job which is displayed at the displaying unit of the printer; 2) col. 11, lines 38-41 describes

that the display unit of the printer requests the user to input the password when the user selects a

print instruction "Print" to the confidential print job).

It would have been obvious to one having ordinary skill in the art at the time the

invention was made to modify the printer of Motegi for requesting a user to input the password

by displaying a message on the displaying unit as taught by Taniguchi. The suggestion for

modifying the printer of Motegi can be reasoned by one of ordinary skill in the art as set forth

above by Taniguchi because the modified printer of Motegi would be reliable by providing the

instruction to guide the user to input his/her password when he/she desires to print the

confidential print job.

9.   Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of

Motegi and Taniguchi, as applied above in view of claim 6, in combination with Uematsu.

As to claim 7, Motegi and Taniguchi disclose every feature discussed in claim 6. Motegi

further teaches the printer controller for controlling the printer apparatus (col. 3, lines 9-10) and

the received print type information is set to be confidential printing (in step S3 in fig. 3 and col.

3, lines 51-52 show the printer receives the confidential print data including the image data and

the information of the registered job number and password).

However, neither Motegi nor Taniguchi teach of sounding an alarm for informing to the

user when the received print type information is set to be confidential printing.

Uematsu, in the same field of endeavor, teaches of sounding as a warning or for notice to

the user by a buzzer (38 in fig. 3)(It is noted that a printer "11 in fig. 3" comprising a controller

"i.e., CPU 32 in fig. 3, col. 4, lines 58-59" which connects and controls to an alarm unit "i.e., a

buzzer 38 in fig. 3" for sounding as a warning or for notice "col. 5, lines 1-2").

It would have been obvious to one having ordinary skill in the art at the time the

invention was made to modify the printer of combination of Motegi and Taniguchi in order to

provide to the user a sounding message, as taught by Uematsu, when the received print data is

the confidential print data. The suggestion for modifying the printer of the combination of

Motegi and Taniguchi can be reasoned by one of ordinary skill in the art as set forth above by

Uematsu because the modified printer of combination of Motegi and Taniguchi would be reliable

and increase functionalities when to have a step of sounding to the user via an alarm unit if the confidential print data is received. Therefore, any of the walkup users would easily know the confidential print jobs those are received by the shared printer in the network.

Allowable Subject Matter

10.   Claims 4-5 are allowed.

Claim 4 is independent claim.

The following is an examiner's statement of reasons for allowance:

As to claim 4, the closest prior art of Motegi (US Patent No. 6,307,640 B1) teaches the host computer creates the job number and password with the print data sent from the user computer via the network computer, and then informs this confidential information to a user at the user computer and a printer; and the closest prior art of Taniguchi et al. (US Patent No. 5,999,707) teaches a printer will request and retrieve the print data stored from the user computer after a user or other users enter a password at the printer. However, each closest prior art or the combination of them fails to teach the features: 1) a printer driver from a computer for providing a print type menu on the display device in which a user can select either general printing or confidential printing with respect to a document and outputting the selected print type information and a print data file; 2) a printer for performing printing the print data file when a code input through an input device is the same as a secret code set in the print type information received from the computer. Therefore, claim 4 would be allowable based on the above reasons.

11.   Claims 8-9 would be allowable if rewritten or amended independent claim 8 to overcome the objection(s), set forth in this Office action.

As to claim 8, the closest prior art of Motegi (US Patent No. 6,307,640 B1) teaches the host computer creates the job number and password with the print data sent from the user computer via the network computer, and then informs this confidential information to a user at the user computer; and the closest prior art of Taniguchi et al. (US Patent No. 5,999,707) teaches a printer will request the print data stored from the user computer after this user or other users enter a password at the printer. However, each closest prior art or the combination of them fails to teach the system including a computer and a printer comprising steps of: 1) requesting a user at the computer to select either general printing or confidential printing of setting a secret code with respect to a document on a print type selection menu screen using an input device; and 2) performing at the printer the printing of the received print data file when it is determined that the input secret code is the same as the secret code set at the computer. Therefore, claim 8 would be allowable based on the above reasons.

Examiner's Remarks

12.   Nezu (U.S. Patent No. 5,970,228) discloses a common output unit such as a print server maintains security when an output request unit sends a job to be processed to the output unit. The output unit accepts and puts the job in queue. The output unit then creates a collation key that is sent back to the output request unit. And a display unit for warning message on the display of the printer with or without alarming sound.

Shima et al. (U.S. Patent No. 6,104,498) discloses the confidential print information is determined at the printer and then the printer requests the user to enter a password.

Nosaki (U.S. Patent No. 5,673,373) discloses an image forming system with security
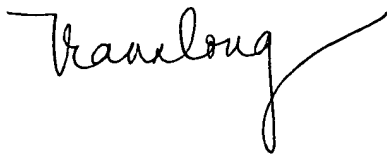
includes a receiving section to receive print data with data showing secrecy attached from

external equipment.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Douglas Q. Tran whose telephone number is (703) 305-4857 or E-mail address is Douglas.tran@uspto.gov.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-4700.

Douglas Q. Tran
Feb. 05, 2003